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1-30-03

Docket No. 4747

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the patent application of Gawler

Serial No. 09/502212

Filing date: February 11, 2000

Title: Accounting for Postal Charges

Group Art Unit 2761 -- Examiner Vig

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Commissioner for Patents  
Washington, D.C. 20231

RESPONSE

Sir:

This is a reply to the office action of July 18, 2002, in which claims 1 - 13 were rejected *en masse* as obvious over four references in combination.

The examiner relied heavily on an electronic document or documents designated "OfficeDepot". We respectfully challenge both the form of the citation, and its substantive sufficiency.

MPEP 707.05(e) provides:

An electronic document is one that can be retrieved from an online source (e.g., the Internet, online database, etc.) or sources found on electronic storage media (e.g., CD-ROM, magnetic disk or tape, etc.). Many references in paper format may also be retrieved as electronic documents. Other references are retrievable only from electronic sources.

The U.S. Patent and Trademark Office follows the format recommended by World Intellectual Property Organization (WIPO) Standard ST.14, "Recommendation for the Inclusion of References Cited in Patent Documents." The format for the citation of an electronic document is as similar as possible to the format used for paper documents of the same type, but with the addition of the following information in the locations indicated, where appropriate:

(A) the type of electronic medium provided in square brackets [ ] after the title of the publication or the designation of the host document, e.g., [online], [CD-ROM], [disk], [magnetic tape];

(B) the date when the document was retrieved from the electronic media in square brackets following after the date of publication, e.g., [retrieved on March 4, 1998], [retrieved on 1998-03-04]. The four-digit year must always be given.

(C) identification of the source of the document using the words "Retrieved from" and its address where applicable. This item will precede the citation of the relevant passages.

(D) specific passages of the text could be indicated if the format of the document includes pagination or an equivalent internal referencing system, or by the first and last words of the passage cited.

Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.

If an electronic document is also available in paper form it does not need to be identified as an electronic document, unless it is considered desirable or useful to do so.

We note that the form of the OfficeDepot item is not in compliance with the above provisions. Item (D) is the most significant omission. In addition, we notice that of the dozen pages provided, only one seems to be dated before the priority date of the present application. The examiner did not indicate under which subsection of 35 USC 102 the documents qualify. Clarification is requested. Please note that a priority document in English has already been submitted, and the priority country is a WTO country.

The examiner admitted that Herring1 does not disclose storing pending values. The one 1998 OfficeDepot document does not disclose in any enabling way the idea of storing pending values, as the examiner maintains at page 4, lines 8 - 19 of office action. We are of the opinion that the entire OfficeDepot citation ought to be

removed as a reference. If it is not, only the 1998 page can be considered. Either way, a case of obviousness cannot be made out.

It is difficult for us to respond completely to the office action because the claims were not rejected or analyzed individually. MPEP 2143.03 reminds us that To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

We respectfully submit that a prima facie case of obviousness against each of the thirteen claims of this application has not been established.



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